



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,920	12/17/2001	Christopher D. Tagge	8500-0247.10	4772
23980	7590	03/09/2004	EXAMINER	
REED & EBERLE LLP 800 MENLO AVENUE, SUITE 210 MENLO PARK, CA 94025			PASTERCZYK, JAMES W	
		ART UNIT	PAPER NUMBER	
		1755		

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	10/023,920	TAGGE ET AL.	
	Examiner	Art Unit	
	J. Pasterczyk	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 January 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-40 and 52-54 is/are pending in the application.
 - 4a) Of the above claim(s) 30-40 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 12-29, 52 and 53 is/are rejected.
- 7) Claim(s) 2-10 and 54 is/are objected to.
- 8) Claim(s) 1-40 and 52-54 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

1. This Office action is in response to the amendment filed 1/29/04 and refers to the first Office action mailed 9/29/03.

2. Applicant's election with traverse of claims 1-29 in Paper No. 9/29/03 is acknowledged. The traversal is on the ground(s) that the proper relationship between the two groups is combination/subcombination and that regardless in an intermediate/final product restriction as done by the examiner the two groups are not truly in such a relationship. This is not found persuasive because when the catalyst and cocatalyst are combined a chemical reaction occurs which changes the chemical identity of both these ingredients, the catalyst becoming an active catalyst whereas before it would not have had any catalytic activity. The combination of the two reagents would not have resulted in merely a mechanical mixture, hence combination/subcombination is not the proper division between the two classes of invention. Thus only one way distinctness need be shown, and the Maeda reference cited in the first Office action supplies sufficient justification for the belief that applicants' structurally similar compounds would likewise have been optical materials, thus having a different use than that of the presently withdrawn catalyst-plus-cocatalyst claims.

The requirement is still deemed proper and is therefore made FINAL.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Reichle as cited in the previous Office action.

Claim 1 currently permits both L groups to be connected to each other as is required by Raichle at the top of col. 2. The second coordinating atom of both L groups of Raichle is an oxygen atom. Two X groups are permitted, corresponding to the Q groups of the present claim.

5. Claims 12-29, 52 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, clause defining M, insert --the group consisting of-- after "selected from" for clearly closed Markush language. In the clause defining the Q groups, penultimate line delete "may" since this is a permissive adverb rather than a definite verb (what may these groups be if they are not the alkylidene olefin etc. or the hydrido etc.?) In the clause defining the R¹ etc. groups, l. 3, delete "may be taken" and "to"; in the penultimate line delete "may". In the clause defining R³ etc., l. 2 delete "may be". In the clause defining the L groups, l. 1 change "may be" to --are--; in l. 3 delete the first instance of "may" and change the other two to --is--; in the last line delete "be". In the last clause, first line delete "(a)"; in l. 2, delete "are taken" and "to".

In claim 25, first line, change "any one" to --either--, and delete "21" since the limitations of claim 25 and its dependents are redundant with those of claim 18 and its dependents when claim 25 depends from claim 21.

In claim 29, clause defining the Q groups, l. 4 delete "may"; in the clause defining the L groups, l. 1, change "may be" to --are--; in l. 3 delete the first "may" and change the other two to --is--; in the last line delete "be".

In claims 52 and 53, fourth line of each delete "may".

6. Claims 2-11 and 54 are objected to as being dependent from an art-rejected claim but would be allowable if the prior art rejection were overcome.

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1755

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700



J. Pasterczyk

AU1755

2/27/04